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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,943

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Gregory Winfield Gorman

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12/04/2006

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EXAMINER

AHMAD, NASSER

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,943

Applicant(s)

GORMAN, GREGORY WINFIELD

Examiner

Nasser Ahmad

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 28-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 28-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Finality Withdrawn

1. The FINALITY of the last Office Action of 5/17/2006 has been withdrawn in view of the newly uncovered prior art for the previously indicated allowable claims 9 and 10.

Prosecution is re-opened and a complete Action on the merit follows:

Allowability Withdrawn

2. Claims 9 and 1: the indicated allowability of these two claims in the last Office Action is withdrawn in view of the newly uncovered prior art of Jacobs (US 20030123930A1) and Cabrera (US006576074B1).

3. **All the rejections made and/or maintained in the last Office Action of 5/17/2006 is being repeated hereinbelow.**

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-8,11,28-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The phrase "homogeneous composition" in claim 1 and 28 is not supported by the specification, as originally filed, because of lack of any definition therefor in the specification. It is not clear as to what is meant by said phrase.

Rejection Withdrawn

6. Claims 1-3, 5, 12 and 14 are rejected under 35 USC 102(b) as being anticipated by Wilson made in the Office Action of March 14, 2005 has been withdrawn in view of the amendment filed on 2/24/2006.

Rejections Maintained

7. Claims 1-5, 7-8, 11, 28-32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Bastiaens (6514655) for reasons of record made in the last Office Action of 10/24/2005.

8. Claims 6, 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiaens for reasons of record made in the last Office Action of 10/24/2005.

Response to Arguments

9. Applicant's arguments filed 2/24/06 have been fully considered but they are not persuasive.

Applicant argues that Bastiaens fails to teach a homogeneous tape body. At first, applicant is informed that the phrase "homogeneous composition" is found to be new matter as discussed above under 35 USC 112, first paragraph. Further, applicant's

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argument is not deemed to be convincing because, as shown in figure-2 of Bastiaens, the layers 34 or 30 are found to be homogeneous. Contrary to applicant's allegation, the presence of additional material is not precluded from the tape body.

The above explanation also apply *a fortiori* to the dependent claims.

In response to applicant's argument that Bastiaens does not teach the limitations of claims 2, 3, 29 and 30, in the context of respective base claims 1 and 28, applicant is informed that the above explanation apply *a fortiori* herein and the limitations of said dependent claims are clearly disclosed in figure-1 of Bastiaens.

Applicant argues that Bastiaens fails to teach a protective tape because Bastiaens sheet (7) is not a tape as it is not bonded to Bastiaens' base construction. This is not found to be persuasive because, as clearly seen in figure-2 of Bastiaens, the layer (7) is a tape that protects the image and the top surface until it is removed therefrom.

Applicant has failed to show that the presence of the layer (7) does not provide protection to the top surface of Bastiaens' tape.

Regarding claims 5-8 and 32-34, applicant's argument that Bastiaens' tape does not teach a pavement tape with a front face comprising at least partially reflective symbol does not make sense. This is because applicant merely contends but fails to show that as to how is the claimed partially reflective symbol different. Applicant has not shown that the image of Bastiaens does not reflect light partially.

As for the railing of claim 11, applicant has failed to show as to how is the railing a part of the claimed tape. In the absence of such showing the railing is considered to be not a

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positive limitation it is used for protecting the tape edge and is attachable to the pavement.

Applicant's argument that Bastiaens fails to teach the claimed tape width of claims 6 and 33. This is not deemed to be persuasive because Bastiaens' tape has a certain width and forming it to have the claimed width of 6-12 inches would have been obvious modification optimum or workable range.

Applicant also argues that Bastiaens' image is not printed on a homogeneous front face. See amendment of 2/24/2006, page 15, item #11. This is not found to be convincing because the phrase "printed on a homogeneous front face" could not be located in the claims and cannot be read thereinto for the purpose of avoiding the applied prior art. The claims only recite that "the symbol is printed on the front face" and not on a homogeneous front face as alleged.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed above.

10. **The new grounds of rejection for claims 9 and 10 are as follows:**

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Cabrera (US006576074B1).

Cabrera relates to a pavement tape (abstract and figure-1) comprising a continuous elongated flexible tape body comprising front and rear faces, said front face comprises at least one symbol conveys information (10), the at least one symbol formed as a perforation (14) extending at least partly from said front face to said rear face of said tape body (figure-2), wherein the front and rear faces are exposed at an end of the continuous elongated flexible tape body (figures-2 or 3).

The intended use phrase such as "for conveying information when affixed to pavement", etc. have not been given any patentable weight because said phrases are not found to be of positive limitation.

13. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Jacobs (US 20030123930A1).

Jacobs relate to pavement tape (figure-1) comprising an elongated flexible tape body (30) comprising front and rear faces (figure-1 shows the two faces of the tape body), said front face comprising at least one symbol that conveys information (figure-1 shows the depression on the front face that is interpreted to convey information such as indicating the location for the adhesive pattern), a mask tape (20), said mask tape

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comprising a flexible mask tape body having front and rear mask faces (as shown in figure-1) and at least one symbol formed as a perforation (32) extending from said front mask face to said rear mask face, said rear mask face of said mask tape being bonded to said front face of the pavement tape (figure-1 wherein the mask tape 20 is bonded to the pavement tape 30).

The intended use phrase such as "for conveying information when affixed to pavement", etc. have not been given any patentable weight because said phrases are not found to be of positive limitation.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nasser Ahmad 11/24/06
Primary Examiner
Art Unit 1772

N. Ahmad.
November 24, 2006.


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